# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/772,298 | 01/29/2001 | Herve Cunin | G-74 | 8603 |

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| 21839 | 7590 | 03/22/2005 | |

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| EXAMINER |
|---|
| STEVENS, THOMAS H |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2123 | |

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _25 January 2005_.

2a)☒ This action is **FINAL**.       2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-4_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-4_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

1.      Claims 1-4 were examined.

### *Response to Applicant's Arguments*

### *35 USC § 112*

2.      Rejections are withdrawn.

### *35 USC § 103*

3.      The examiner finds applicant's arguments as non-persuasive. The motivation to combine is to simply instill an emulation protocol or standard, EISA standard specifically ISO/IEC 7816, which the Renner reference does not teach; but recognizes the importance of inclusiveness within this particular genre of art (Renner: column 1, lines 57-65). This motivation combats applicant's argument of Renner's non-discloser of a particular type emulation set forth in the claims (applicant's response: pg. 6, line 1 and lines 1-13), as well as the and GET-RESPONSE command (applicant's response: pg. 7, lines 1-2).

### *Final Rejection*

### *Claim Rejections - 35 USC § 103*

4.      The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

      1.     Determining the scope and contents of the prior art.

      2.     Ascertaining the differences between the prior art and the claims at issue.

      3.     Resolving the level of ordinary skill in the pertinent art.

      4.     Considering objective evidence present in the application indicating

obviousness or nonobviousness.

5.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed

or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter

as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall

not be negatived by the manner in which the invention was made.


6.     Claims 1-4 are rejected under 35 U.S.C. 103 (a) as unpatentable by Europay

International S.A. ("Integrated Circuit Card Specification for Payment Systems" (1995)),

in view of Renner et al., (U.S. Patent 5,679,945 (1997)).

The Euorpay International S.A. (EISA) teaches data elements and commands to

the exchange of information between and integrated circuit card and a terminal (pg.1-1,

lines 1-3) based on ISO/IEC 7816 series of standards (pg. 1-1, 5th paragraph); but

doesn't teach an emulation process. Renner et al. teaches an intelligent card reader to

replace existing magnetic strip readers, bar code, bar code readers and Wiegand effect

readers without the need for expensive retrofitting of existing computer systems which are coupled to the existing readers (abstract), while supplying various emulation features (column 5, lines 65), which are use well know ISO standards (column 8,lines 59-61).

At the time the invention, it would have been obvious to one of ordinary skill in the art to use Renner et al. to modify (EISA) since it would be advantageous to mimic routine transactions while retrofitting the operational code for full optimization, while providing cards which generally comply with an ISO standard or software interfaces which can be used across different vendor cards (Renner: column 1, lines 60-65).

Claim 1. A method of emulating a chip card reader (Renner: emulation section—column 5, lines 65-67 through column 8, lines 1-5) functioning according to the PSCS standard (Renner: column 8, lines 58-61; and EISA: pg. 5-2, section 5.4.1 with 5.2.1 and 5.2.2) in order to manage a chip card reader functioning according to the EMV standard and communicating with the chip card according to the protocol T= 0, (EISA: pg. 6-3, section 6.1.3 with table 4) comprising the following steps: (a) determining the types of APDU exchanges for which emulation is to be effect (EISA: pg. 6-3, section 6.1.3 with table 4); (b) emulating the return of a state word in compliance with the standards of the PCSC environment (EISA: pg. 6-7, section 6.4); (c) when the type of APDU exchange corresponds to a Case 2 as defined in ISO 7816-4 (EISA: pg. 6-3, section 6.1.3 and 6.2.1) receive the command C-APDU complying with the state word (EISA: pg. 6-3 through 6-4 with table 6); (d) when the type of APDU exchange corresponds to a case 4

as defined in the standards (EISA: pg. 6-3, section 6.1.3), receiving the command GET-REPONSE using the state word; (e) returning R-APDU in response to C-APDU or to GET-RESPONSE (EISA: pg.6-12, section 6.5.3).

Claim 2.  A method according to Claim 1, (Renner: emulation section—column 5, lines 65-67 through column 8, lines 1-5; EISA: pg. 5-2, section 5.4.1 with 5.2.1 and 5.2.2) wherein the operations (c) and (d) are in reverse order (EISA: pg. 6-1, paragraphs 2 and 3).

Claim 3. A method according to Claim 1, (Renner: emulation section—column 5, lines 65-67 through column 8, lines 1-5; EISA: pg. 5-2, section 5.4.1 with 5.2.1 and 5.2.2) wherein the operation (c) (EISA: pg. 6-1, paragraphs 2 and 3) is followed by the following step: ($c_1$) emulating the return of a state word, complying with the standards of the PCSC environment as provided for when the type of APDU exchange corresponds to a case 4 (Renner: column 7, lines 51-67 with EISA: pg. 6-3, section 6.1.3 with table 4).

Claim 4. A method according of emulating a chip card reader (Renner: emulation section—column 5, lines 65-67 through column 8, lines 1-5) functioning according to the PSCS standard  (Renner: column 8, lines 58-61; and EISA: pg. 5-2, section 5.4.1 with 5.2.1 and 5.2.2) in order to manage a chip card reader functioning according to the EMV standard and communicating with the chip card according to the protocol T = 0,

comprising the following steps: determining the types of APDU exchanges for which

emulation is to be effected, emulating an alarm state (EISA:pg. 6.4 through 6-5,

"warning processing"; and Renner: column 8, lines 54-67), which can relate to the

application of the chip card, and sending to the PCSC environment the state word

complying with the standards of the PCSC environment (Renner: column 7, lines 51-67

with EISA: pg. 6-3, section 6.1.3 with table 4), when the type of APDU exchange

corresponds to a case 2 as defined in ISO 7816-4, receiving the command C-APDU

complying with the state word, receiving the command GET-RESPONSE (EISA: pg.6-

12, section 6.5.3) parameterized such that the number of bytes awaited is 0 (EISA: pg.

6-4, section 6.2.3), and emulating a state word, (EISA: section 6.2.2 ) complying with

the standards, to the PCSC environment as provided for when the type of APDU

exchange corresponds to case 4.

### *Conclusion*

7.      **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action.  In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
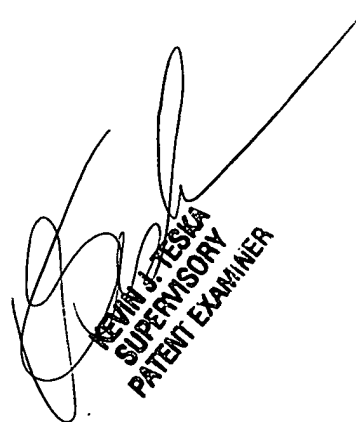
### *Correspondence Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Tom Stevens whose telephone number is 571-272-3715, Monday-Friday (8:00 am- 4:30 pm) or contact Supervisor Mr. Kevin Teska at (571) 272-3716. Fax number is 571-273-3715.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.


March 17, 2005


THS